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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,124	08/27/2003	Steven R. Reznik	03073	5523
<div>7590 Martha Ann Finnegan, Esq. Cabot Corporation 157 Concord Road Billerica, MA 01821-7001</div>			<div>EXAMINER ALEXANDER, LYLE</div>	
			<div>ART UNIT 1743</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/650,124

Applicant(s)

REZNEK ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 26-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119.

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/2/04, 12/27/03, 3/7/05, 7/21/05, 12/1/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- ☐ Notice of Informal Patent Application
- ☐ Other: ____

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 3-25, drawn to a method of tagging a product classified in class 436, subclass 56.
- II. Claims 2 and 27, drawn to method of doing business, classified in class 705.
- III. Claims 26 and 28-48, drawn to a method of representing characteristics, classified in class 434.
- IV. Claims 49-65, drawn to a method of particle manufacture, classified in class 524.
- V. Claims 66-68, drawn to a method of distinguishing between two different grades, classified in class 35.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different invention of group I are related to a method of creating a tagging material that has a different mode of operation and effect not contemplated by the other inventions.

Inventions II and III-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different invention of group 2 is directed to a business method that has a different designs, modes of operation, and effects not contemplated by the other inventions.

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Inventions III and IV-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different invention of group 3 is directed to a method of representing information that has a different designs, modes of operation, and effects not contemplated by the other inventions.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different invention of group 4 is directed to a method of particle manufacture that has a different designs, modes of operation, and effects not contemplated by the other inventions .

During a telephone conversation with Mr. Kilky on 1/30/07 a provisional election was made with traverse to prosecute the invention of group I, claims 1 and 3-25.

Applicant in replying to this Office action must make affirmation of this election. Claims 2 and 26-68 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. One having ordinary skill in the art would not be able to make and or use the invention as presently claimed. Below are examples of some of the 35 USC 112 second paragraph issues with the instant claims.

Claim 1 is not clear what method is contemplated. It is not clear what is intended by "creating" and "a product specification".

Claims 3 are confusing what is being claimed. Are Applicants' claimed recording information about the product ? If this is true, these steps may not be statutory subject matter.

Claim 4 is confusing what method is performed by "specifying". Are Applicants' actually measuring/testing anything or merely recording product information. Is the "determining" step a mental process ?

Claim 5 is confusing what method is performed by the claimed "determining comprises".

Claims 6-7,10 are confusing what is intended by the "specifying comprises characterizing..." and "specifying". Is there any analyses performed or are these mental steps.

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Claims 8,11 are confusing what method is being performed by "... the morphological value is included on a product specification sheet ...". Are Applicants' claiming recording product specifications on a sheet ?

Claim 9 is confusing if any measurement steps are taking place. It appears Applicants' are just stating the morphological values. Is there any method step or even a mental step ?

Claim 12 merely states the chemical values can be pH, functional group level, etc. Are there any method steps performed ?

Claims 13-16 do not appear to further limit claim 1 because no method steps are claimed. Describing what the compound *could be* does not further limit the claimed "method for creating a product specification ...". These limitations have been considered, but have been given little weight as they are not related to the claimed method.

Claims 17-19 are confusing what method steps are performed to by the claimed "absorptometry method".

Claim 19 "absorptometry" appears to be a typographical error. The Office will assume "absorptometry" was intended.

Claims 20 is not clear what method steps are intended by the claimed "wicking rate method".

Claim 21 is not clear what method steps are intended by the claimed "yield point method".

Claim 22 is not clear what method steps are intended by the claimed "interfacial potential vapor adsorption method".

Claim 23 is not clear what method steps are intended by the claimed "ICG method".

Claims 24 is not clear what method steps are intended by the claimed "adsorption, vapor adsorption method".

Claims 25 is not clear what method steps are intended by the claimed "adsorption method using iodine...".

In light of all of the 35 USC 112 second paragraph issues above, the Office best understands the invention as a method of tagging with a particle that has identifiable characteristics.

The Examiner acknowledges receipt of the multiple information disclosure statement. Thus, there is no requirement that applicants explain the materiality of these references, however the cloaking of a clearly relevant reference in a long list of references or in an overly lengthy reference may not comply with applicants' duty to disclose, see Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338. The Examiner has considered these references in same manner as references encountered during a normal search of Office search files. There is no duty to consider these references to a greater extent than those ordinarily looked at during a regular search by the Examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mansky (US 2003/0097871).

In light of all of the 35 USC 112 second paragraph issues above, the Office best understands the invention as a method of tagging with a particle that has identifiable characteristics.

Mansky teach in paragraph [016] using a tag to identify a pellet. This has been read on the claimed “method for creating a product specification...” because the tag identifies the pellet and its characteristics/specifications. The limitations to the specific tagging materials have been considered but given little weight as they are not related to the claimed method (see the above 35 USC 112 second paragraph rejections).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
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